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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/630,049

07/30/2003

James A. Truc

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7590

09/10/2004

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EXAMINER

GRAY, DAVID M

ART UNIT

PAPER NUMBER

2851

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/630,049

Applicant(s)

TRUC ET AL.

Examiner

David M Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kahle in view of Kraft et al.

Applicant acknowledges that the reference to Kahle discloses an arrangement wherein title information wherein title information identifies the digital information that is recorded on a medium is provided on the medium.

Applicant argues that there is no disclosure or suggestion in Kraft et al. that would suggest that the index print as disclosed by Kraft et al. can be applied to a CD or disk in the manner as claimed. The examiner cannot agree. The teaching provided by Kraft et al. is that an index print serves as a table of contents for photographic data. One of ordinary skill in the art would recognize that such a table of contents, although in graphic instead of text format, is equivalent to the table of contents set forth in Kahle. It would have been obvious to one of ordinary skill at the time of applicant's invention to substitute the suggested table of contents taught by Kraft et al. for the table of contents disclosed by Kahle. One would have been motivated to so modify Kahle in order to provide a table of contents that allows a user to quickly ascertain the contents of the photographic data stored on the disk in Kahle.

Applicant further argues that the layout of the images on the surface of the disk is not merely printed matter but serves to patentably distinguish over the combination of Kahle and Kraft

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et al. The examiner cannot agree. Once the combination is made and an index print is to be provided as the table of contents for the disk, the layout of the images thereon clearly becomes printed matter.

Claims 8-40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Otake et al., Ishikawa et al. and Wess.

Contrary to applicant's remarks, Wess clearly discloses "an index print which is attachable to its associated image recording medium" (col 1, lns 14-15) and an "index print serves the purpose of quickly and clearly informing a person of the exact image content recorded on the image recording medium" (col 1, lns 29-31). The fact that the specific embodiment shown in Wess is directed to a film cartridge having a film door does not negate this teaching as urged by applicant. Otake et al. clearly discloses as equivalents several types of image recording mediums including film and optical disc. Clearly when the image recording medium is an optical disc the index print would be directly attached thereto as taught by Wess.

Applicant further argues that the layout of the images on the surface of the disk is not merely printed matter but serves to patently distinguish over the combination of Kahle and Kraft et al. The examiner cannot agree. Once the combination is made and an index print is to be provided as the table of contents for the disk, the layout of the images thereon clearly becomes printed matter.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Gray whose telephone number is 571-272-2119. The examiner can normally be reached on M-T 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'David M Gray', with a large, stylized flourish extending from the end of the signature.

David M Gray  
Primary Examiner  
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